

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

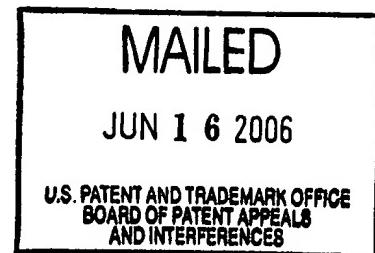
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHASE A. HAFNER, WILLIAM R. MUTSCHLER,
BRIAN J. WALKER and DAVID S. JOYCE

Appeal No. 2006-1131
Application 09/421,038

ON BRIEF



Before THOMAS, HAIRSTON and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for managing information and rendering discounts in a billing system.

Representative claim 1 is reproduced as follows:

1. A method for managing information and rendering discounts in a billing system, the method comprising:

receiving a customer record including data;

establishing a rule-based accumulation engine including a non-application specific, configurable, system that processes input data to produce output data where the processing is dictated by a set of configurable rules;

processing the record with the accumulation engine to accumulate the data in a plurality of predetermined target accumulators;

establishing a rule-based discount engine including a non-application specific, configurable, system that processes input data to produce output data where the processing is dictated by a set of configurable rules; and

processing the plurality of target accumulators with the discount engine to render discounts applicable to the customer.

The examiner relies on the following references:

Benyacar et al. (Benyacar)	5,003,584	Mar. 26, 1991
Jagadish et al. (Jagadish)	5,915,006	June 22, 1999
		(filed May 01, 1997)

The following rejections are on appeal before us:

1. Claims 1, 10 and 11 stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Benyacar.

2. Claims 1-4, 6-14 and 16-19 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by Jagadish.

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3. Claims 5 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jagadish.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections of the claims on appeal. Accordingly, we affirm.

We note that this application was previously on appeal [Appeal No. 2003-1048, decision mailed September 7, 2004]. In that appeal, a panel of the Board affirmed the exact same rejections that are currently on appeal before us. In response

to that decision, appellants filed a request for continued examination (RCE) under 37 CFR § 1.114. That request was accompanied by an amendment to the independent claims. In particular, using claim 1 as an example, the phrase "including a non-application specific, configurable, system that processes input data to produce output data where the processing is dictated by a set of configurable rules" was added to each of the "establishing" steps after the recited "engine." As noted above, despite these amendments to the independent claims, the examiner has maintained the same rejections that were of record in this case.

We consider first the examiner's rejection of claims 1, 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Benyacar. The rejection requires that we consider the rules that follow.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital

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Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572,

1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to independent claim 1, the examiner finds that Benyacar discloses the claimed invention except that Benyacar does not teach accumulating the data in a plurality of predetermined target accumulators. The examiner, finds, however, that the operation disclosed by Benyacar inherently meets the

claimed predetermined target accumulators. With respect to the amendment made to claim 1 in the (RCE), the examiner finds that Benyacar discloses "both a rule-based accumulation engine and a rule-based discount engine, including a *non-application specific, configurable system*...that process input data to produce output data where the processing is dictated by a set of *configurable rules*." The examiner notes that Benyacar teaches application flexibility which reads on a non-application specific system. The examiner also notes that this application has provided no special definition for the phrases "configurable system" and "configurable rules" [answer, pages 4-5].

Appellants argue that the examiner has simply restated the old rejections and failed to consider the amendments made to the claims in the RCE. Appellants argue that Benyacar does not teach the two rule-based engines of claim 1. Appellants contend, without explanation, that Benyacar is application specific, is not a configurable system, and does not involve processing dictated by configurable rules as claimed [brief, pages 5-8].

The examiner responds that full consideration of the claim amendments was given in the rejection. The examiner asserts that the issue before us is still one of claim interpretation. The

examiner argues that there is no clear definition of "configurable system" and "configurable rules" in the disclosure. Accordingly, the examiner asserts that it is proper to give these terms their broadest reasonable interpretation. The examiner notes that the rejection indicates how these terms are met when they are given their broadest reasonable interpretation. The examiner notes that appellants' arguments fail to address this broadest reasonable interpretation of the claims [answer, pages 6-8].

Appellants respond generally that Benyacar does not disclose the specific method recited in claim 1. Appellants also argue for the first time in this appeal that it is not inherent that Benyacar operate in the same way as recited in claim 1. Specifically, appellants argue that the use of separate engines as claimed, each having configurable rules, is not the same as a general teaching of generating bills. Appellants assert that even if the examiner's broad interpretation of the claims is used, the claimed target accumulators are not inherent in Benyacar [reply brief].

We will sustain the examiner's rejection of claim 1 as anticipated by, or in the alternative, as unpatentable over

Benyacar. We agree with the examiner that Benyacar fully meets the claimed invention when the terms of the claim are given their broadest reasonable interpretation. The processor of Benyacar produces a billing record that clearly has rules for accumulating data for each customer and rules for determining the discounts [column 8, lines 43-44] which should be assigned to the accumulated data. As noted in the previous decision, the data in Benyacar is accumulated in predetermined target accumulators associated with each billing rule and associated with each customer. As noted by the examiner in the rejection, the processing of the AMA record in Benyacar requires that the data of the AMA record be stored in target registers or accumulators for processing by the billing system. We are also not persuaded by appellants' arguments regarding the two rule-based engines. There is no specific definition of the term "engine." Since Benyacar teaches that customer data is accumulated and discounted, we agree with the examiner that Benyacar provides "engines" for performing these functions. Since the billing and discounts are determined by a set of rates stored in memory, we also agree with the examiner that these amounts are rule-based. Benyacar discloses that the rate information can be modified by

the sponsor at any time which means that the accumulation and discount engines use a set of configurable rules. Finally, Benyacar discloses that the flexibility provided allows various applications of the invention to be implemented in the network [column 10, lines 26-27]. We interpret this disclosure to meet the claim recitation that the accumulation and discount engines are non-application specific. Appellants have not provided us with specific details as to why the examiner's findings fail to support the rejection. As noted in the previous decision, claims are given their broadest reasonable interpretation during prosecution. The examiner's interpretation of claim 1 is consistent with this rule, and the examiner has properly determined the scope of claim 1. We note that appellants' specification offers no specific definition for any of the argued terms of claim 1. Appellants' general assertions that Benyacar does not disclose the claimed invention without specifically addressing the examiner's findings do not persuasively rebut the examiner's rejection.

Since appellants' arguments with respect to claims 10 and 11 are essentially the same arguments we considered with respect to claim 1, we also sustain the examiner's rejection of claims 10 and 11.

We now consider the examiner's rejection of claims 1-4, 6-14 and 16-19 under 35 U.S.C. § 102(e) as being anticipated by Jagadish. The examiner has indicated how he reads the claimed invention on the disclosure of Jagadish [answer, pages 5-6]. Appellants argue that the examiner has not shown any teaching in the prior art of the features added by amendment in the RCE. Appellants broadly assert, without explanation, that Jagadish fails to disclose that the rules are configurable, the system is configurable and that the system is not application specific [brief, pages 9-10]. The examiner responds that appellants have failed to consider the broadest reasonable interpretation applied by the examiner [answer, page 8].

We will sustain the examiner's rejection of claims 1-4, 6-14 and 16-19 based on Jagadish. As noted above, the examiner has given the claims their broadest reasonable interpretation. The examiner cites the flexibility of Jagadish [column 4, lines 23-34] as evidence that the system of Jagadish is a non-application specific system. Appellants have not responded to this specific finding of the examiner. The examiner also finds that the various rate rules disclosed by Jagadish meet the claim limitation that the rules and engines are configurable.

Appellants have not specifically responded to this finding either. We agree with the examiner that appellants have failed to address the specific findings made by the examiner in support of the rejection. To the extent that appellants are relying on the specific definitions for the subject matter added in the RCE, these arguments fail for the reasons discussed above with respect to the rejection based on Benyacar. Appellants' general assertions that Jagadish does not disclose the claimed invention without specifically addressing the examiner's findings do not persuasively rebut the examiner's rejection.

We now consider the examiner's rejection of claims 5 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Jagadish. The examiner has indicated how he finds the invention of these claims to be obvious over the teachings of Jagadish [answer, page 6]. Appellants' only argument with respect to claims 5 and 15 is that these claims are dependent claims and are believed to be patentable [brief, page 10].

We will sustain the examiner's rejection of claims 5 and 15. Since we find that the examiner has established a prima facie case of the obviousness of claims 5 and 15, and since appellants have offered no arguments to rebut the rejection, we

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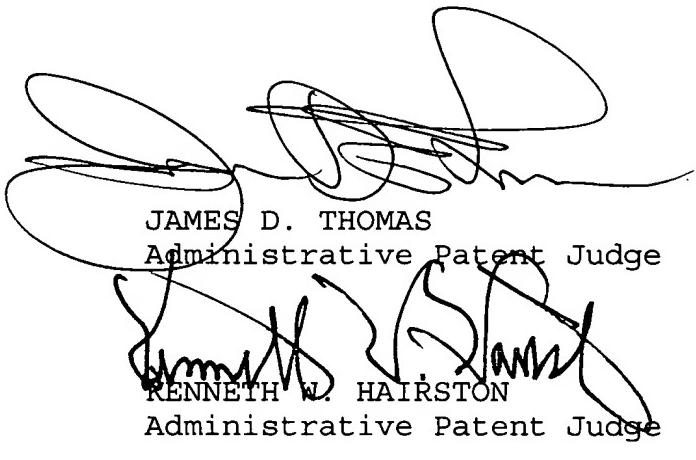
find claims 5 and 15 to be unpatentable for the same reasons discussed above.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-19 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED



JAMES D. THOMAS)
Administrative Patent Judge)
KENNETH W. HAIRSTON)
Administrative Patent Judge)
Jerry Smith)
JERRY SMITH)
Administrative Patent Judge)
BOARD OF PATENT
APPEALS AND
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